

Appl. No. 10/804,587
Amdt. dated Aug. 1, 2005
Office Action mailed Feb. 1, 2005

REMARKS/ARGUMENTS

It is believed that a three-month extension of time is required. As noted above, a Petition for a three-month extension of time was filed earlier today via separate cover. Fourteen claims have been amended, five claims have been canceled and no new claims have been added. Consequently, it is believed that no other fees have been generated by this filing. If it is determined that any additional fees are due in this application, the Commissioner is hereby authorized to charge Deposit Account No. 19-2260 in the amount of such fees.

Section 2 of the Office Action objects to the format of claim 19. It is noted that claim 19 does not conclude with a period mark. Upon review of the pending claims, the undersigned has noticed that claims 11 and 16 also lack a concluding period mark. In addition, a typographical error has been discovered in the text of claim 50. The amendments presented above add concluding period marks to claims 11, 16 and 19 and correct the typographical error in claim 50.

Sections 3 and 4 of the Office Action reject the pending claims under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 5,821,523 and claims 1-20 of U.S. Patent No. 6,330,975. In particular, the Office Action discusses pending claims 1, 2, 8, 24, 25, 30 and 35, claim 1 of the 5,821,523 patent and claims 2, 3 and 7 of the 6,330,975 patent. The Office Action states that the claims are not patentably distinct from each other.

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Applicants respectfully disagree with the double patenting rejection. It is believed that the claims are patentably distinct from each other. The rejection begins by reciting the features of pending claims 1 and 35 and issued claim 1 of USP 5,821,523. The focus of the written analysis in the rejection is primarily on these three claims. First, the undersigned notes the "portable" and "optical reader subsystem" distinctions in the claims. Second, the undersigned notes the "decode" distinction between claim 1 of USP 5,821,523 and pending claims 1 and 35.

Further, Applicants believe that the Examiner has not established a *prima facie* case of nonstatutory-type double patenting. At least three factors are required to establish such a case. First, the rejection must identify the inventions claimed in the claims under consideration and in the patent claims. Second, the rejection must establish that any variation between the inventions claimed in the claims under consideration and the earlier-issued patent claims would have been obvious to a person of ordinary skill in the art. Third, the rejection's showing of obviousness must follow the analysis used to establish a *prima facie* case of obviousness. The initial burden to establish such a case is on the Examiner. Further, the rejection must include clear evidence to establish why alleged variations of an invention claimed in a prior patent would have been obvious. A mere finding by an Examiner that the claims themselves are obvious variations is not legally sufficient. In the instant case, it is believed, for example, that the second and third requirements have not been satisfied.

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Consequently, it is requested that the double-patenting rejection be reconsidered and withdrawn.

Sections 5 and 6 of the Office Action reject claims 1-14 and 23-62 under 35 U.S.C. §102(b), as being anticipated by U.S. Patent No. 6,040,856 of Yuji Sakaegi (Sakaegi). Applicants respectfully disagree with the interpretation and application of Sakaegi presented in the Action. For example, the rejection of former claim 2, regarding the use of two optical paths (see now amended claim 1) states that Sakaegi processes image data differently from character data. Such processes, however, are unrelated to the use of two different "optical" paths to capture coded and photo image information. Sakaegi does not disclose the use of two different optical paths.

In addition, there does not appear to be a specific explanation of the rejection of claim 57. Applicants are of the opinion that the cited Sakaegi reference does not disclose the combination presented in claim 57.

Sections 7 and 8 of the Office Action reject claims 15-22, 63 and 64 under 35 U.S.C. §102(b) as being unpatentable over U.S. Patent No. 4,983,996 (Kinoshita). Applicants respectfully disagree with this rejection. Kinoshita, for example, does not disclose the use of two different optical paths.

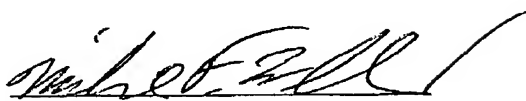
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Applicants believe that the above remarks provide a complete response to the issues presented in the Office Action. Further, as a result of the demonstrated allowability of the claims, a Notice of Allowance is respectfully requested.

Respectfully Submitted,

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Date

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